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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/857,353 | 09/05/2001 | Alfred Heinzl | | 3131 |

27187 7590 05/24/2004
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EXAMINER

SHARMA, RASHMI K

ART UNIT PAPER NUMBER

3651

DATE MAILED: 05/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/857,353

Applicant(s)

HEINZL ET AL.

Examiner

Rashmi K. Sharma

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/23/2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 18 is/are rejected.
- 7) ☒ Claim(s) 5-17 and 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claim Rejections - 35 USC 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims rejected 1-4 and 18 are under 35 U.S.C. 103(a) as being unpatentable over Matsuzoe (EP 0660655).

Matsuzoe discloses a transport system for small components, arranged in series comprising a chain having a plurality of chain links (2) having a through opening cavity formed therein having at least 2 walls where one wall is rigid and another wall is resilient (see figure 1), a central web (center of 13) having resilient arms (either ends of 13) laterally extending therefrom and extending from the full height within the cavity. Matsuzoe also discloses the resilient arms having their upper ends being freestanding, the outside rigid wall having a slope (see figure 1).

Matsuzoe fails to disclose the resilient wall oriented opposite of the rigid wall.

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the wall arrangement of Matsuzoe's invention with that of the Applicant's invention, thereby changing the resilient wall opposite to the rigid wall to provide for a range of different sized conveyed electrical components.

Allowable Subject Matter

3. Claims 5-17 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed 2/23/2004 have been fully considered but they are not persuasive.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

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Applicant argues that modifying Matsuzoe's invention and arranging the rigid wall opposite the resilient wall, is contrary to Matsuzoe's teaching. However, the Examiner would like to point out that in the Summary of the Invention section Matsuzoe discloses, "When the foremost tray arrives at dogs (19) formed along the opposite edge portions of the guide groove (18), the contacts (15) of the rocking plates (13) will come into engagement with the dogs (19) so that each plate (13) rocks about the fulcrum (12). The locking pawl (16) will thus be retracted outwardly in a seesaw-like manner so as not to hinder an IC chip (B) from being smoothly put into the recess (1), as will be seen in FIG. 4." It would be obvious to one having ordinary skill in the art, to appreciate that modifying Matsuzoe's invention by replacing one of the resilient walls with a rigid wall, would allow for fewer movable parts and a solid, secure structure to thereby seat and hold in place the electrical components being conveyed. Applicant's arrangement, however appears to limit the size range of the electrical components that can be used and requires that the components be in a more specific size range, in order to be securely seated and conveyed.

Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the claims avoid such references or objections. Regardless of how many rigid walls Matsuzoe is modified to have, two or three, Matsuzoe still discloses the specific structure of a combination of rigid walls and resilient walls as does the Applicant's independent

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claims. Therefore Applicant fails to show the novelty behind having 3 rigid walls versus having 2 rigid walls in light of the prior art of record.

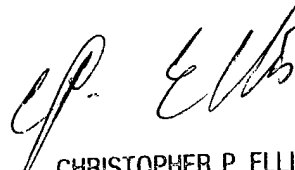
Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Rashmi Sharma who can be reached at 703-306-5952 between the hours of 8:30 a.m. to 5:00 p.m. Monday through Friday.

Any general inquiry concerning the status of this communication should be directed to the Group receptionist who can be reached at 703-308-1113.


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